

### **REMARKS**

This responds to the Office Action mailed on January 26, 2005.

Claims 1, 3-4, 6, 8-9, 11, and 13 have been amended. No claims have been canceled or added. As a result, claims 1-13 are now pending in this application.

For the convenience of the Examiner, Applicant's remarks concerning the claims will be presented in the same order in which the Examiner presented them in the Office Action.

### **Information Disclosure Statement Previously Submitted on November 8, 2004**

Applicant filed an Information Disclosure Statement on November 8, 2004. To date, Applicant has not received the Form 1449 filed therewith and marked as being considered by the Examiner. Pursuant to the provisions of MPEP 609, Applicant requests that a copy of the Form 1449, initialed as being considered by the Examiner, be returned to the Applicant with the next official communication to indicate that the cited documents have been considered by the Examiner.

### **Amendments to the Specification**

On page 1, Applicant has updated the status of the parent application.

### **Amendments to Claims 1, 3-4, 6, 8-9, 11, and 13**

Claims 1, 3-4, 6, 8-9, 11, and 13 have been amended. No new matter has been introduced.

In claims 1, 3, 6, 8, 11, and 13, the word "less" has been substituted for "greater", and the word "greater" has been substituted for "less. Support may be found in the original written description for this, for example, on page 17, lines 1-12.

In claim 4, the words "operator-depressible" have been added. Support may be found, for example, on page 6, line 8.

In claim 9, the words “operator-actuatable” have been added. Support may be found, for example, on page 6, line 6.

The amendments to the claims are made to satisfy Applicant’s preferences, not necessarily to satisfy any legal requirement(s) of the patent laws, and they are not intended to limit the scope of equivalents to which any claim element may be entitled.

**Rejection of Claims 1, 4-6, and 9-11**  
**under 35 U.S.C. §102(b)**  
**as Anticipated by Hood**

Claims 1, 4-6, and 9-11 were rejected under 35 U.S.C. §102(b) as being anticipated by Hood (U.S. 5,352,230).

Hood discloses a pneumatic tool having a chamber 24 (FIG. 2), a first port 44 (FIG. 3), a second port 46, a reciprocating shuttle 36 (FIG. 2b), an anvil 122, and a control unit 12 (FIG. 1). During a first (percussive) part of a cycle, air pressure is applied to the first port 44, and vacuum is applied to the second port 46 (col. 13, lines 1-5), driving the shuttle to the distal end of the chamber to strike the anvil. During a second (recovery) part of a cycle, vacuum is applied to the first port 44, and pressure is applied to the second port 46, to return the shuttle to the proximal end of the chamber.

The rule under 35 U.S.C. §102 is well settled that “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP §2131.

Hood fails to disclose all of the structural elements recited in claim 1, as amended. For example, Hood fails to disclose *inter alia* that the control mechanism is to provide vacuum to the supply hose when air within the pilot hose has less than a predetermined pressure, and wherein the control mechanism is to provide air pressure to the supply hose when air within the pilot hose has greater than the predetermined pressure.

For the above reasons, claim 1 should be found to be allowable over Hood, and Applicant respectfully requests that the rejection of claim 1 under 35 U.S.C. §102(b) as anticipated by Hood be withdrawn.

Regarding independent claim 4, as amended, Hood fails to disclose *inter alia* a first operator-depressible actuation element and a second operator-depressible actuation element. For the above reasons, claim 4 should be found to be allowable over Hood, and Applicant respectfully requests that the rejection of claim 4 under 35 U.S.C. §102(b) as anticipated by Hood be withdrawn

Claims 5-6, which depend from claim 4 and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above.

Regarding independent claim 9, as amended, Hood fails to disclose *inter alia* a first operator-actuatable actuation element and a second operator-actuatable actuation element. For the above reasons, claim 9 should be found to be allowable over Hood, and Applicant respectfully requests that the rejection of claim 9 under 35 U.S.C. §102(b) as anticipated by Hood be withdrawn

Claims 10-11, which depend from claim 9 and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above.

#### **Allowable Subject Matter**

Applicant notes with appreciation that claims 2, 3, 7, 8, 12, and 13 were objected to as being dependent upon a rejected base claim, but they were indicated as being allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In view of Applicant's preceding remarks concerning the asserted patentability of independent claims 1, 4, and 9, Applicant does not wish to rewrite claims 2, 3, 7, 8, 12, and 13 in independent form at this time, but Applicant respectfully reserves the right to do so at a later time.

**Conclusion**

Applicant respectfully submits that claims 1-13 are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, Walter W. Nielsen (located in Phoenix, Arizona) at (602) 298-8920, or the below-signed attorney (located in Minneapolis, Minnesota) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

ALTON W. HEZELTINE

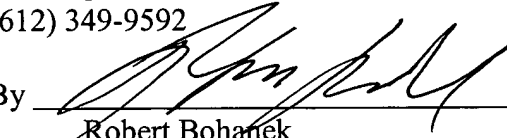
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3/24/05

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 24th day of March, 2005.

Name

Dennis J. Kaph

Signature

